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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,651	08/20/2003	Stephen F. Mase	14491.01	5444
7590	11/01/2007			
Devan V. Padmanabhan DORSEY & WHITNEY LLP Intellectual Property Department 50 South Sixth Street, Suite 1500 Minneapolis, MN 55402-1498			EXAMINER GOLDMAN, MICHAEL H	
			ART UNIT 4127	PAPER NUMBER
			MAIL DATE 11/01/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/644,651	MASE ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Michael H. Goldman	4127

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 20 January 2007.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \*    c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____. _____	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

1. The following is a non-final, first office action on the merits. Claims 1-20 are pending.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2, 4 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2, line 2 claims "the matching agent". There is insufficient antecedent basis for this limitation in the claim.

In claim 4, line 1 claims "the plurality of databases". There is insufficient antecedent basis for this limitation in the claim. It is suggested that claim 4 read "the plurality of distributed databases".

In claim 5, line 1 claims "the databases". There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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5. Claim 20 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed transmission medium is broadly construed to be a transmission signal that is non-statutory.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. **Claims 1-13, 15-17 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Schiff et al. (20030158777).**

**As per claim 1**, Schiff et al. discloses the claimed marketing system that matches a customer profile to marketing offers, the marketing system comprising:

a database including customer profile containing information related to a customer's interests in products or services (see page 4 [0077] and Fig 1B discloses client database, portfolio database ,RMCS,CRM and Ad Server whereby the databases are linked as a system via the AS, (see [0064] ),to produce the equivalent of the database containing all of the elements; also see [0082] for matching function of customer profiles and messages to be sent, examiner construes messages to be offers);

a data base including a plurality of marketing offers related to products and services (see page 1 [0011] lines 5-6 whereby a number of banners, examiner construes as offers, as an example, are shown to the surfer (customer) as desired by the surfer; also see [0082] lines 8-9 whereby the system may include a Rich Media Campaign Server which builds the files that hold all the relevant information and sends it to the AS to start the process of showing the relevant message(s)/offer(s) to the relevant surfer/user, examiner construes these messages as a plurality of marketing offers);

a server for executing a program operable to match a selected offer of the plurality of marketing offers to the customer profile (see FIG 1B, Administration Server (AS) and page 11, claim 1.iii, lines 1-3 whereby *messages*, examiner construes as *marketing offers*, are displayed according to user portfolio);

**As per claim 2**, Schiff et al. further discloses the system wherein the program is operable to present marketing offers to each customer, based on the results of the matching agent (see page 11, claim 1.iii, for displaying offer, lines 1-3 and 2.ii for matching from the database and claim 3.iii for generating one or more messages, examiner construes as marketing offers, and claim 16 wherein a system for messaging over a data messaging makes the invention operable);

**As per claim 3**, Schiff et al. further discloses the system wherein the marketing offers are located on a plurality of distributed databases, the database in communication through a communication network (see page 3[0064] lines 1-11 whereby the AS, which contains data relative to all the databases including advertising messages, construed by

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examiner as marketing offers, whereby the AS may physically be one or a plurality of servers/databases, which may be physically located at the same or at different locations on the net; also see claims 3.ii and 3.iv which discloses selecting messages/marketing offers from a database and transferring the message(s) selected to the sent to one or more selected customers via a server, claim 1.i);

**As per claim 4**, Schiff et al. further discloses the system wherein the plurality of databases are located on-site at a company originating at least one of the marketing offers (see page 3 [0064] lines 1-5 and 8-10 which discloses the system wherein the plurality of databases (contained in AS) may be physically located at different locations on the net, construed by examiner to include originating company with at least one of the marketing offers);

**As per claim 5**, Schiff et al. further discloses the system wherein the databases are directly coupled to the server (see page 3 [0064] lines 1-3 wherein the administrative server (AS) contains the data base hence this is construed as being directly coupled and line 8 whereby the AS may physically be one or a plurality of servers);

**As per claim 6**, Schiff further discloses a system including a client computer in communication with the server via a communication network (see Fig 1A whereby client computer, labeled as "U1" with figure of user computer connected to WWW, the communication network via AS, Administration Server);

**As per claim 7**, Schiff et al. further discloses the system wherein the client computer includes an applet received from the server (see page 2 [0044] lines 4-7

whereby embedded sources or subroutines, ActiveX control are addressed as one of the preferred embodiments; the ActiveX enables browser is a species of an applet);

**As per claim 8**, Schiff et al. further discloses the system wherein the applet is configured to prompt the customer using the client computer to enter the customer profile (see page 5 [0089] lines 1-3 and whereby FIG 2C is an example of portfolio update/registration via a feature embedded into plug-in the browser, examiner construes as an applet, FIG 2C discloses an example of a *prompt* "Add Company" item 200, which initiates an update to portfolio, in the browser window);

**As per claim 9**, Schiff et al. further discloses wherein the applet is further configured to communicate the customer profile to the server (see FIG 2C and [0089] lines 7-9 whereby the plug-in/applet causes the selection of a profile by users to create a URL of the desired provider to be added and further discloses (see [0093] lines 6-12) that the plug-in is configured to communicate the customer profile to AS when the Provider decides it wishes to communicate via the AS to the user plug-ins);

**As per claim 10**, Schiff et al. further disclose the system wherein the applet is configured to notify the customer at the client computer upon occurrence of a match to the selected offer (see page 5 [0093] lines 16-17; whereby users store their personal data, construed by examiner as user requesting message/offer, on the plug-ins/applet and see lines 18-19 whereby as soon as the company/providers activate the database of users who have registered, construed by examiner as requesting messages/offers, the AS will contact their plug-ins and transfer requested data/messages/offers to the proper place of the consumers details; also see page 6 [0096] whereby as soon as the

user activates his account, he will see a list of companies that want to send him messages/offers via the AS);

**As per claim 11**, Schiff et al. discloses a marketing method for matching a plurality of company offers with a plurality of customer profiles, the method comprising evaluating the plurality of offers and customer profiles and matching a selected offer to a selected customer profile (see abstract whereby a system for messaging (see page 1 [0011] line 2 – whereby *messaging* and *advertisement* are the same, and examiner construes *advertisements as offers*) over a data network allows every registered user with one or more profiles, construed by examiner as a plurality of customer portfolios, containing information relative to providers of which the user is willing to view, construed by examiner as a plurality of offers; also see [0082] and FIG 1B, whereby the method of matching offers and user profiles is managed by the AS to match customer profiles and offers via the CRM, Portfolio, Clients Data Base and RMCS);

**As per claim 12**, Schiff et al. further discloses communicating the selected offer(s) to the customer/user (see page 2 [0019] lines 1-3 displaying to one or more users on their terminal, *messages*, construed by examiner as *advertisements/offers* according to the information contained in their portfolio/profile);

**As per claim 13**, Schiff et al. further discloses the method wherein the selected offer/message is communicated to a client computer via a computer network (see [0027] lines 1-3 whereby the *terminal*, can be any device with Internet connectivity or with any other digital media connectivity, e.g. a Personal Computer (PC));

**As per claim 15**, Schiff et al. further discloses the method wherein customer profile includes an *identification of the customer* and a preference of the customer (see page 5 [0093] lines 1-2 wherein according to an embodiment of the invention, the user can add any URL that he wished to his portfolio/profile, construed by examiner as customer preference; also see [0093] lines 8-13 whereby users who have asked to register with their AS *ID*, construed by examiner as *customer identification*);

**As per claim 16**, Schiff et al. discloses a marketing method for matching a plurality of company offers with a plurality of customer profiles, the method comprising evaluating the plurality of offers and customer profiles and matching a selected offer to a selected customer (see abstract whereby a system for messaging over a data network allows every registered user with one or more profiles, construed by examiner as a plurality of customer portfolios, containing information relative to providers of which the user is willing to view, construed by examiner as a plurality of offers; also see page 1 [0011] lines 1-4 whereby a user-driven advertisement method and system which increases the effectiveness of advertisements which reach the user, examiner construes this as the marketing method for matching users and providers; also see page 5 [0093] lines 11-13 whereby the company/provider send through the AS a message/offer to users requesting details that would match the AS ID to the customer ID);

**As per claim 17**, Schiff et al. further discloses the method of communicating at least one offer to a customer corresponding to the selected customer profile (see page 4 [0082] lines 10-11 whereby the process of showing the relevant message(s) to the

relevant surfer, examiner construes that each surfer/user will be shown at least one offer/message based upon their profile/portfolio);

**As per claim 20**, Schiff et al. discloses a system by which a computer data signal embodied in a transmission medium, comprising a first code segment for soliciting a customer *profile*, the profile including a customer *identification* and a customer *preference*, and a second code segment for receiving a marketing *offer* from a company (see page 3 [0064] lines 1-7 whereby the AS operates the system (over a network, see FIG 1A, construed by examiner to be the transmission medium) which contains data relative to users' portfolio/profile/preference and a database of the content provided by the providers, construed by examiner as the marketing offer from a company; also see page 4 [0076] lines 16-20 which discloses the coding/interface protocol for achieving the match of the customer preference, and the marketing offer is well understood by the skilled person, and is therefore not discussed herein in detail, for the sake of brevity).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**9. Claims 14, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schiff et al. and further in view of Eggleston et al. (6061660).**

As per claim 14, Schiff et al. disclose the method whereby customer preferences/profiles and matching provider/company messages/offers (see page 1 [0011] lines 5-6 whereby a number of banners, examiner construes as offers, are shown to the surfer (customer) as desired by the surfer).

However, Schiff et al. does not expressly disclose the step of fulfilling the selected offer with its corresponding company.

Eggleston et al. discloses a system and method for incentive programs and award fulfillment over a computer network (see [54] and abstract [57] lines 1-2) and page 6, column 2, lines 32-35 whereby via a host computer connected to the network, a client computer of a consumer connected to the network, a sponsor computer connected to the network sponsor computer, and lines 44-46, via a *fulfillment* automation application program for *associating* a fulfillment method with an award. Examiner construes award fulfillment the same process necessary to receive, service and track orders via Direct Marketing.

Both Schiff et al. and Eggleston et al disclose a method for corresponding users and providers for goods and/or services for efficient and effective delivery via use of a network. Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify the Schiff et al. marketing system that matches a customer profile to marketing offers to include an automated fulfillment method as taught by Eggleston et al. in order to expressly complete the marketing transaction.

**As per claim 18**, Schiff et al. further discloses at least one offer uses a portion of the customer profile (see page 1 [0011] line 2 whereby all offers are user-driven, hence all equates to at least a portion of a customer profile), however Schiff et al. does not expressly disclose the step of fulfilling the offer.

Eggleston et al. discloses a system and method for fulfillment on a network (see [54] and page 1, lines 23-25 whereby the present invention relates particularly to systems and methods [of fulfillment] over computer networks, such as the internet).

Both Schiff et al. and Eggleston et al disclose a method for corresponding users and providers for goods and/or services for efficient and effective delivery via use of a network. Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify the Schiff et al. marketing system that matches a customer profile to marketing offers to include an automated fulfillment method as taught by Eggleston et al. in order to expressly complete the marketing transaction.

**As per claim 19**, Schiff et al. fails to disclose a method wherein the customer profile includes a mailing address.

However Eggleston et al. discloses the method wherein the customer profile includes a mailing address (see column 13 lines 10-12 FIG 17, the consumer database 202 includes records that may include the name 800, address 802...).

Both Schiff et al. and Eggleston disclose a method for collecting and storing customer profiles. Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify the Schiff et al. marketing system for collecting and storing a customer profile to include a consumers address as taught by Eggleston et al. in order to expressly complete the marketing transaction by use of a mailing address.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Wolfe, Mark A. (6341305) discloses a system and method for communicating information relating to a network resource.

Danielsen et al. (7171448) discloses conducting activities in a collaborative work tool architecture.

Apte et al. (7225142) discloses interactive multimedia advertising and electronic commerce on a hypertext network.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael H. Goldman whose telephone number is 571-274-5101. The examiner can normally be reached on Monday thru Thursday 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynda Jasmine can be reached on 571-270-3033. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

mhg

  
Elaine Gord  
Primary Examiner